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| APPLICATION NO. | FILED DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|------------|----------------------|---------------------|------------------|
| 09/773,893 | 02/02/2001 | Colin C.O. Goble | | 3292 |

7590 03/15/2004

Nixon & Vanderhye PC
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714

EXAMINER

DAHBOUR, FADI H

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**SUPPLEMENTAL
Notice of Allowability**

| | | |
|-----------------|--------------|--|
| Application No. | Applicant(s) | |
| 09/773,893 | GOBLE ET AL. | |
| Examiner | Art Unit | |
| Fadi H. Dahbour | 3743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTO-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to supplemental IDS filed on 12/11/2003.

2. The allowed claim(s) is/are 1-40.

3. The drawings filed on 02 February 2001 are accepted by the Examiner.

4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of the:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

6. CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) hereto or 2) to Paper No./Mail Date _____.

(b) including changes required by the attached Examiner's Amendment / Comment or in the Office action of
Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date <u>8</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

RDH

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37CFR1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Robert A. Molan on 03/10/2004.

Claims 1, 22 and 36-39 have been amended as follows:

1. (Currently Amended) An electrosurgery system for treating tissue immersed in an electrically conductive fluid, comprising:-

a generator for delivering a radio frequency tissue treatment output in the frequency range of from 100 kHz to 50 MHz, and

an elongate instrument shaft configured to be mounted at a proximal end to a handpiece and carrying at its distal end a bipolar electrode assembly connected to the generator, wherein the electrode assembly includes:-

an active electrode with an active zone at a distal end of the active electrode; and
a return electrode with a return zone near the active zone;

wherein ~~at least one~~ both of the active and return zones has an electrically insulating dielectric covering such that in use a radio frequency electrical circuit between the active and return electrodes through the conductive fluid is completed primarily by dielectric coupling through the dielectric covering.

22. (Currently Amended) An electrosurgical instrument for treating tissue immersed in an electrically conductive fluid with radio frequency energy in the frequency range of from 100 kHz to 50 MHz, wherein the instrument comprises an elongate shaft configured to be mounted at a proximal end to a handpiece and carrying at its distal end a bipolar electrode assembly which includes:-

an active electrode with an active zone at a distal end of the active electrode; and
a return electrode with a return zone near the active zone;

wherein ~~at least one~~ both of the active and return zones has an electrically insulating dielectric covering such that in use a radio frequency electrical circuit between the active and return electrodes through the conductive fluid is completed at least primarily by dielectric coupling through the dielectric covering.

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36. (Currently Amended) An electrosurgical instrument for use at a frequency or frequencies in the range of from 100kHz to 50 MHz, the instrument having a bipolar electrode assembly for tissue treatment when immersed in a conductive fluid, wherein the instrument comprises an elongate shaft mounted at one end to a handpiece, and carrying the electrode assembly at its other end, and wherein the electrode assembly comprises at least one distal active electrode, and an adjacent return electrode set back proximally of the active electrode, the active and return electrodes being encased in an insulative dielectric layer.

37. (Currently Amended) A laparoscopic electrosurgical instrument for wet field electrosurgery, wherein the instrument comprises a tubular elongate shaft for insertion into a body cavity and, at the end of the shaft for insertion into the body cavity, an electrode assembly comprising a first conductor at an extreme distal end of the instrument and a second conductor insulated from the first conductor and set back from the distal end, wherein ~~at least~~ the first and second conductors ~~is~~ are encased in an insulative outer dielectric layer.

38. (Currently Amended) An electrosurgical system for treating tissue structure contained within a body cavity and immersed in an electrically conductive fluid, said system comprising:

a generator for delivering a radio frequency output for the treatment of tissue structures in the high to very high frequency range; and

an electrode assembly connected to said generator, said electrode assembly comprising:
an active electrode including an active zone at a distal end of said active electrode;
a return electrode including a return zone defined by an electric field developed between said active electrode and said return electrode when said electrode assembly is connected to said radio frequency output of said generator; and

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an insulator separating said return electrode from said active electrode; ~~said return both zones~~ being coated with a layer of dielectric insulating material wherein, in use, said return zone is insulated from direct electrical contact with said tissue and said electrically conductive fluid so that an electrical circuit is completed between said active and return zones by dielectric coupling through said dielectric insulating material.

39. (Currently Amended) An electrode assembly for treating tissue structure contained within a body cavity and immersed in an electrically conductive fluid, said electrode assembly being connected to a generator for delivering a radio frequency output for the treatment of tissue structures in the high to very high frequency range, said electrode assembly comprising: an active electrode including an active zone at a distal end of said active electrode;

a return electrode including a return zone defined by an electric field developed between said active electrode and said return electrode when electrode assembly is connected to said radio frequency output of said generator; and

an insulator separating said return electrode from said active electrode;

~~said return both zones~~ being coated with a dielectric insulating material layer wherein, in use, said return zone is insulated from direct electrical contact with said tissue and said electrically conductive fluid so that an electrical circuit is completed between said active and return zones by dielectric coupling through said dielectric insulating material.

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2. The following is an examiner's statement of reasons for allowance:

The prior art of record, including U.S.6632193B1 cited on the supplemental IDS filed on 12/11/03, does not teach or fairly suggest the recitations of the specific features of the electrosurgical system for treating tissue, of claims 1, 22, 36-40, including especially the following:

The primary reason for the allowance of independent claims 1 and 22 is the inclusion of both the active and return zones having an electrically insulating dielectric covering.

The primary reason for the allowance of independent claim 36 is the inclusion of both the active and return electrodes being encased in an insulative dielectric layer.

The primary reason for the allowance of independent claim 37 is the inclusion of both the first and second conductors being encased in an insulative outer dielectric layer.

The primary reason for the allowance of independent claim 38 is the inclusion of both zones being coated with a layer of dielectric insulating material.

The primary reason for the allowance of independent claim 39 is the inclusion of both zones being coated with a dielectric insulating material layer.

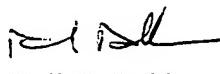
The primary reason for the allowance of independent claim 40 is the inclusion of the active electrode being in the form of a ceramic cavity lined internally with metal, the ceramic cavity being a dielectric insulating material, and an electrical circuit is completed between the active and return zones by dielectric coupling.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479. The examiner can normally be reached on M-F, 9am-5:30pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Fadi H. Dahbour
Examiner
Art Unit 3743

INFORMATION DISCLOSURE
CITATION

(Use several sheets if necessary)

| | | | |
|------------------------|----|-----|------------|
| A | Da | No. | Serial No |
| 2 | 49 | | 09/773,893 |
| Applicant Goble et al. | | | Group |
| Filing Date | | | |
| February 2, 2001 | | | 3743 |



U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER | DATE | NAME | CLASS | | FILING DATE IF APPROPRIATE | |
|---------------------|-----------------|---------|----------------|-------|----------|-------------------------------|--|
| | | | | CLASS | SUBCLASS | | |
| FHD | 6,632,193 B1 | 10/2003 | Davison et al. | | | | |
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FOREIGN PATENT DOCUMENTS

TRANSLATION

| DOCUMENT | DATE | COUNTRY | CLASS | SUBCLASS | YES | NO |
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent pages, etc.)

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| Examiner | Fadi H. Dahbour | Date Considered | 3/10/04 |
|----------|-----------------|-----------------|---------|

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application.

#800646 v1 - 1440 to 12/11/02 supp ids

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of

GOBLE, et al.

Atty. Ref.: 2558-49

Patent No. 6,758,846 B2

Issued: July 6, 2004

For: AN ELECTROSURGICAL INSTRUMENT AND AN
ELECTROSURGERY SYSTEM INCLUDING SUCH AN
INSTRUMENT

* * * * *

June 8, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR A CERTIFICATE OF CORRECTION

The patentee in the above-identified patent hereby requests that the Patent and Trademark Office issue an official Certificate of Correction pursuant to 37 C.F.R. § 1.322 for the following error made by the Patent Office.

Column 15, line 59, change "at least one" to -- both --.

Column 17, line 41, change "at least one" to -- both --.

Column 18, line 51, before "return", insert -- active and --, and change "electrode" to -- electrodes --.

Column 18, line 60, change "at least the second conductor is" to -- the first and second conductors are --.

Column 19, line 10, change "said return zone" to -- both zones --.

Column 20, line 3, change "said return zone" to -- both zones --.

GOBLE, et al.
Patent No. 6,758,846 B2

Attached hereto is a draft Official Certificate of Correction for use by the Patent and Trademark Office correcting the above-identified errors.

Since the error arose on the part of the Patent and Trademark Office, as evidenced by the fact that the Examiner's Amendment included with the Supplemental Notice of Allowability, mailed May 4, 2004, was not entered in Application Serial No. 09/773,893, filed February 2, 2001, the application underlying the above-identified patent, no fee is believed necessary for securing issuance of the Certificate.

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: Robert A. Molan
Robert A. Molan
Reg. No. 29,834

RAM:drt
901 North Glebe Road, 11th Floor
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Facsimile: (703) 816-4100

Staple
Here
Only!

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,578,846 B2
DATED : July 6, 2004
INVENTOR(S) : GOBLE, et al.

It is certified that errors appear in the above-identified patent and that said letters patent is hereby corrected as shown below:

Column 15, line 59, change "at least one" to -- both --.

Column 17, line 41, change "at least one" to -- both --.

Column 18, line 51, before "return", insert -- active and --, and change "electrode" to -- electrodes --.

Column 18, line 60, change "at least the second conductor is" to -- the first and second conductors are --.

Column 19, line 10, change "said return zone" to -- both zones --.

Column 20, line 3, change "said return zone" to -- both zones --.

MAILING ADDRESS OF SENDER:

Robert A. Molan
NIXON & VANDERHYE P.C.
901 North Glebe Road, 11th Floor
Arlington, Virginia 22201

PATENT NO. 6,758,846 B2

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